

No. 22208

IN THE
United States Court of Appeals
for the Ninth Circuit

EDOCO TECHNICAL PRODUCTS, INC.,
Plaintiff-Appellant,

VS.

PETER KIEWIT SONS' CO., and
THE B. F. GOODRICH COMPANY,
Defendants-Appellees.

PLAINTIFF-APPELLANT'S REPLY BRIEF

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**DEFENDANTS-APPELLEES' ARGUMENTS ARE
FALLACIOUS IN THE FOLLOWING RESPECTS**

**A. Re Defendants' Argument That The District Court's
Non-Compliance With Local Rule 4 Should Not Have Been
Grounds For Reversal.**

Plaintiff-Appellant's first ground of argument set forth at Page 20 of its opening brief is that the District Court's non-compliance with Local Rule 4(g) was per se grounds for reversal. Defendants' opposition to this argument appears at Page 25 of their Brief under the heading "Appellants' Day in Court on Findings 27-33."

It should first be noted that subsequent to the time of the hearing on the Motion for Summary Judgment, the Local Rules for the Central District were revised and apparently renumbered, whereby former Local Rule 4(g) became present Rule 3(g). The text of such rule remained identical, however.

Defendants argue that plaintiff's attack upon Findings 27-33 and the procedural steps culminating in their adoption and filing is based upon a misconception since Rule 52(a) F.R.C.P. provides that findings are unnecessary on decisions for a Motion for Summary Judgment. The fallacy of defendants' argument will be clearly evident to this Court. Admittedly, findings need not be made for a Motion for Summary Judgment. Such fact, however, does not afford an excuse for non-compliance with Local Rule 3(g) since such Local Rule is not contrary to the F.R.C.P.

Defendants' contention on Page 26 of their Brief that the provisions of the Local Rule "seems to be mainly for the purpose of focusing the points in controversy" is likewise fallacious. The only logical reason for requiring the moving party to set forth its proposed findings and conclusions is to permit the opposing party to bring before the District Court and thus enter into the record all evidence justifying opposer's position. The present case provides a perfect example of the reason for this rule. Thus, it will be noted that defendants' Brief devotes Pages 20-25 to arguments that the alleged file wrapper estoppel precludes construing defendants' waterstop enlargements as being the equivalent of the serration means

of the patent claims. Such arguments are based upon Findings 27-33. Plaintiff was precluded from introducing affidavits or other evidence controverting these arguments in connection with the Motion for Summary Judgment *simply and solely because plaintiff had not been provided with notice that findings of this nature would be relied upon by the District Court as partially justifying its ruling on the Motion.*

With regard to defendants' contention that the serration means appear in the record in connection with the Motion for Summary Judgment, it should be noted that such references were only incidental to the issue of infringement. Thus, at R 173 the reference is merely a general description of appellant's waterstop; at R 188 and R 221 the reference is to a description of appellees' waterstop; the Worson affidavit at R 257 merely recites the functional equivalency of plaintiff's and defendants' waterstops; the arguments presented in open court June 5, 1967 were *solely arguments on the part of defendants' attorney and prior to the hearing plaintiff's attorney was not even aware such arguments were going to be made.*

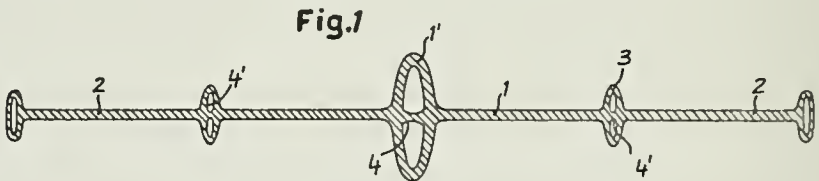
Accordingly, plaintiff was in fact deprived of its day in Court with respect to Findings 27-33 by the District Court's failure to comply with the Local Rule.

B. Re Defendants' Argument That A File Wrapper Estoppel Was Clearly Established.

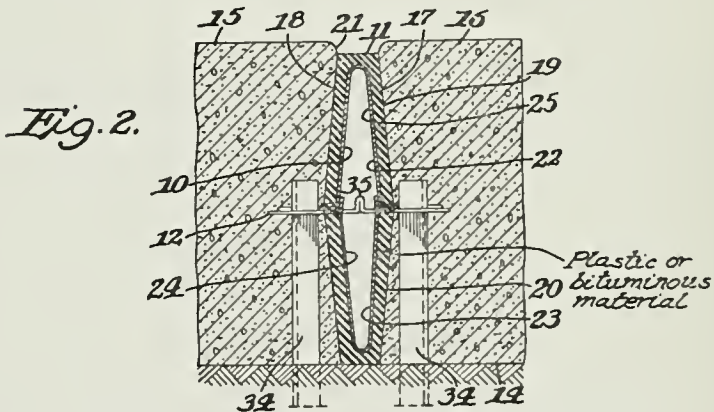
1. The tapering language.

Appellees' argue that plaintiff is precluded from asserting defendants' straight-sided vertical band falls within the scope of patent Claims 1 and 2 because such

tapering language was added to the claims to overcome a rejection on the prior art. Appellees' argument, however, conveniently overlooks the fact that at the time of the rejection tapered bands were old in the art, as represented for example by Wey Patent No. 2,901,904 and Jacobson Patent No. 2,025,209. These patents appear as Exhibits D and M to the Book of Patents filed in support of Defendants' Motion for Summary Judgment. In view of the importance of this point, Figs. 1 and 2, respectively, of these two patents appear immediately herebelow:



Wey Patent No. 2,901,904



Jacobson Patent No. 2,025,209

Referring first to the Wey patent, there is shown a synthetic plastic packing strip to be interposed between joints in cement. The strip includes horizontal arms 2 that extend outwardly from the opposite

sides of a vertical element 4. The vertical element 4 is seen to taper upwardly and downwardly from its midportion.

Jacobson discloses an expansion and contraction joint interposed between adjoining lengths of concrete roadway. The Jacobson joint includes a vertically extending band 10 which tapers upwardly and downwardly from its midsection to terminate in upper and lower horizontal edges 11. Jacobson was cited by the Patent Examiner during the prosecution of the patent in suit and accordingly such Examiner knew full well it was old to provide a tapered vertical band in concrete roadway joints.

Since the use of a vertically tapered band in a concrete roadway joint was old in the art, the present case is on all fours with the *International Manufacturing Co. v. Landon* case appearing at Page 21 of Plaintiff-Appellant's Opening Brief. Accordingly, there is no reason why this Court should not reach the same conclusion in this case as it reached in the *International* case.

This case and the *International* case differ factually from the cases cited in defendants' Brief. In the cases cited by defendants there is no indication that the limitations added to the questioned claims to effect the allowance of such claims were old in the prior art.

2. As to the serration means.

As noted previously herein, the District Court made Findings 27-33 without complying with the then Local Rule 4(g). Accordingly, plaintiff had no opportunity to introduce evidence controverting such findings as

they pertained to the alleged file wrapper estoppel in connection with the serration means element of the patent claims. Fortunately, however, the record does include prior art showing serration means to be old in the art at the time the patent in suit was prosecuted. Thus, Fig. 2 of British Patent No. 646,268 appears as Exhibit L in the Book of Patents filed with the Motion for Summary Judgment. A copy of Fig. 2 of the British patent appears at Page 33 of Plaintiff-Appellant's Opening Brief.

Referring to such drawing, there is shown a synthetic plastic joint interposed between the adjacent concrete blocks. The joint includes a tubular central portion 5 from the opposite sides of which extend horizontal wings formed with longitudinal serrations 7. This British patent was likewise before the Patent Examiner during the prosecution of the patent in suit. Thus, in accordance with the doctrine expressed in the *International* case, the recitation of the serration means could not be the heart of the invention, since such serration means were old in the art at that time. It is accordingly not true as contended by defendants that the doctrine of equivalents cannot be applied to the serration means element so as to preclude plaintiff from construing Claims 1 and 2 broadly enough to read on defendants' waterstop-forming enlarged beads.

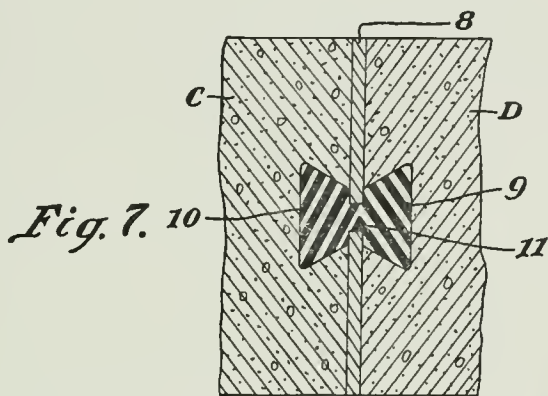
C. Re Defendants' Argument That The Worson Invention Is A Narrow One In A Crowded Art.

Defendants contend at Page 16 of their Brief that the Worson invention is narrow rather than of a

pioneering nature because Fischer Patent No. 2,540,251 illustrates and describes exactly what was new and patented by Worson.

This contention is at complete odds with the actual facts.

To clearly demonstrate the fallacious nature of defendants' statement, there appears herebelow a copy of Fig. 7 of the Fischer patent:



Fischer Patent No. 2,540,251

Referring to the above drawing, there is shown one of several forms of contraction joints for a concrete pavement. It is important to note that Fischer did not contemplate continuous paving of a concrete roadway, but instead discloses “two adjacently poured concrete slabs” (Column 1, line 36). The oppositely directed cross-hatching of the adjacently poured concrete slabs C and D in Fig. 7 also make it clear that Fischer did not contemplate continuous paving. It is uncontested that in pouring an elongated concrete structure continuous paving is absolutely essential. As pointed out at Page 4 of the Plaintiff-Appellant’s

Opening Brief, it was the Worson invention which made it practical to utilize continuous paving.

Next, it will be noted that Fischer's band does not effect fracturing of the concrete above and below its upper and lower edges as with Worson's invention. Fischer does not disclose a fracturing band at all, but rather he discloses a "cleavage-defining" band. In Fischer, upon contraction of the two adjacently poured concrete slabs, one slab pulls away from the other along the vertical plane defined by Fischer's band. Thus, it will be apparent that Fischer does not even disclose a "weakened plane joint," but instead merely discloses the now-discarded "contraction joint." How then can defendants conscientiously contend Fischer illustrates and describes the Worson invention?

If any further argument is required to establish that Fischer fails to disclose what was new and what was patented by Worson, it need only be pointed out that *defendants did not copy Fischer's "contraction" joint, but instead copied plaintiff's "weakened plane joint."*

D. Since A File Wrapper Estoppel Does Not Exist, The Doctrine Of Equivalents Applies And There Is No Question But That Defendants Infringe.

Defendants do not even contest the fact that defendants' structure performs substantially the same function in substantially the same way to obtain the same result as the patented combination. As noted in Plaintiff-Appellant's Opening Brief, the evidence before the District Court clearly established such equivalency. Thus, in accordance with the doctrine of

equivalents as expressed by this Court in *Nelson v. Batson* appearing at Page 24 of Plaintiff-Appellant's Opening Brief, Claims 1 and 2 are clearly infringed.

E. Re Defendants' Invitation To This Court To Find The Patent Invalid.

Defendants' Brief includes an invitation to this Court to find the patent in suit invalid even though the District Court held that:

“As to the question of validity and misuse of the patent, no determination can be made upon a Motion for Summary Judgment as material questions of fact still remain to be resolved.” (Record 329)

Defendants' argument for invalidity is that the German Gebrauchsmuster 1,756,880 discloses a fracturing band similar to the fracturing band of the claimed combination and that to utilize such German band in wet concrete would be obvious in the light of several other patents. The fallacy of such contention is firmly established by the following statement from the Worson Affidavit:

“a) German Petty Patent No. 1,756,880 does not show the combination of a paving section formed with a weakened plane joint by means of of a resilient band having upper and lower portions, the top and bottom edges of which define straight edges disposed below the top surface of the paving section and above the lower surface of the paving section, such strip being formed with horizontally extending sealing strips that define waterstops when the paving cures, and such sealing strips also permitting relative move-

ment between the portions of the paving section on either side of the weakened plane joint. Instead, the German Petty Patent refers to joints in overlays made of plaster, insulation or floor covering compositions. These overlaps are placed on top of solid concrete floors or roofs in buildings. As is well known, one of the first operations in construction of buildings with concrete floors and roofs is to pour the concrete. One of the last operations will be to apply the plaster or other type of floor covering because of the likelihood of scratching or gouging of such covering during subsequent work on the building. Overlays are never laid at the same time when concrete slab is placed. In buildings there is not as much temperature changes as on paving slabs where sun heats the slab and provokes movement of the slab so that in buildings the temperature is much more even. Therefore, there is no need of large expansion joints in the concrete and a weakened plane joint can be used at greater intervals than on highways. Plaster floor coverings cannot use weakened plane joints because of appearance requirements and instead use expansion joints. Such expansion joints have to be scrupulously placed in the same vertical plane as the weakened plane joints of the concrete. Otherwise, the concrete joint will crack the finish covering above and form unacceptable random cracks. The German patent accomplished exact presetting of the plaster expansion points by forming the weakened plane slot in the concrete slab 16 and later anchoring the bottom fin 10 of the plastic strip in the existing void in the concrete. This plastic strip comes flush to the top of the overlay thus forming a neat, straight, finished line in the upper surface of the plaster

9. This sequence of operations is shown by the three diagrams appearing across the top of Exhibit A, such diagrams being designated Drawing No. C.

To form the slot in the concrete slab 16, a conventional saw cut such as shown at No. 3 of Exhibit A could be used, or an insert left in such as shown at No. 2 of Exhibit A. Probably, this insert will be most practical because during the construction period after the concrete is poured but before the plaster overlay is poured dirt and dust will accumulate in these slots and it would not be easy to clean them. The insert will be removed just before placing the plastic. It certainly would not be practical to leave the German plastic strip imbedded in the concrete slab 16 until such time as the plaster covering 9 is poured because it would be difficult if not impossible to finish the concrete slab around this strip. Also, such strip would seriously interfere with all construction activities on the slab during the construction of the rest of the building. Accordingly, it will be clear that the German patent contains not even the slightest suggestion that the plastic strip could be used to form a weakened plane joint in a concrete canal lining or the like." (Record 252-254)

From the above language it will be clear that the German Petty Patent fails to provide any suggestion whatsoever that the strip shown therein could have been utilized in the weakened plane joint claimed in the patent in suit. With particular regard to the lack of obviousness of utilizing the German strip in a continuously paved concrete joint, the following language from the Worson Affidavit is completely

dispositive:

“That defendants’ Motion For Summary Judgment asserts I did not make a valid invention because my patented joint would have been obvious. Such obviousness is refuted by the fact that after I introduced my invention the most experienced concrete experts in the United States did not believe it would work and it took me several years of hard work to change their minds. The objections they presented were serious ones and could be refuted only by field experience which was very difficult to obtain and required great financial sacrifices.” (Record 256)

The record before this Court indicates the invention of the patent in suit was most unobvious. Accordingly, there is no justification for defendants’ suggestion that this Court hold such patent invalid.

F. Re Defendants’ Contention That A Case For Summary Judgment Was Fully Established.

Plaintiff-Appellant’s Opening Brief final argument is that the District Court erred in finding there was no issue of material fact on the question of non-infringement. Defendants’ opposing argument begins on Page 28 of their Brief. Defendants’ argument relies primarily upon a quotation from *Sanitary Refrigerator Co. v. Winters* and a statement that this Court is in accord with the quoted language in view of the *Kwikset*, *Oxnard Cannery* and *Rohr Aircraft* decisions.

Defendants’ reliance upon these four cases as justification for the decision of the District Court in this case is completely inapropos.

Neither the *Sanitary Refrigerator* nor the three cited Ninth Circuit cases dealt with a Motion for Summary Judgment. Instead, these cases each involved a trial, with the evidence coming before the appellate tribunal being undisputed. Thus, the Supreme Court in the *Sanitary Refrigerator Co.* case carefully pointed out that it could resolve the question of patent infringement as a matter of law because there was no disputed evidence before it. In *Kwikset*, this Court pointed out that “there is no dispute as to the evidentiary facts.” In the *Oxnard Cannery* case this Court held “it appears that no substantial dispute of facts is presented.” Defendants’ reliance upon the *Rohr Aircraft* case is not understood by plaintiff since in *Rohr* this Court disposed of the case by holding the patent invalid and infringement was not even considered.

It will therefore be clear that this case differs completely from the cases relied upon by defendants. In this case, as noted at Page 34 of Plaintiff-Appellant’s Opening Brief, the Utecht Affidavit presented a disputed issue of fact as to the reason the “tapering” language was added to the patent claims. Defendants’ contend the tapering language was added solely to overcome the prior art rejection whereby a file wrapper estoppel resulted. Plaintiff contends that such tapering language was added in conjunction with other functional language to better distinguish the principle of the entire combination over British Patent No. 646,268. The undisputed facts established by the file history of the patent in suit and the prior art could lead to a conclusion that either plaintiff’s ver-

sion of such disputed fact is correct or conversely defendant's version of such disputed fact is correct.

The District Court elected to resolve this disputed evidence in favor of defendants. Accordingly, the District Court acted directly contrary to the direction of this Court set forth in *Neff Instrument Corp. v. Cohu Electronics, Inc.*, 269 F.2d 668 (August 1959):

"On a motion for summary judgment the burden of establishing the non-existence of any genuine issue of fact is upon the moving party, all doubts are resolved against him, * * * On appeal from an order granting defendants' motion for summary judgment the Circuit Court of Appeals must give the plaintiff the benefit of every doubt."

If this Court gives the plaintiff herein the benefit of doubt, this case will be remanded to the District Court for trial.

Respectfully submitted,

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CERTIFICATE

I certify that, in connection with the preparation of this Brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that in my opinion, the foregoing Brief is in full compliance with those rules.

Francis A. Utecht